

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-2, 4-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,424,524 issued to Rupert, et al. in view of Official Notice that "both concept and the advantages for providing USB cable for data communication between the computer and the peripheral device are well known and expected in the art." In particular, the Examiner states that with regards to independent claims 1 and 7, Rupert teaches "a computer peripheral device (see figure 1, personal scanner), comprising:

circuitry to perform a computer peripheral function (see figure 1, personal scanner, element 18, wherein within the scanner comprises at least one circuitry to perform scanning (see column 5 lines 34-47);

RS232 cable that provides a connection to a computer (see figure 1 element 40 and column 6 lines 3-5, wherein the personal scanner communicates with the store's computer via RS232 port 40);

IR (infrared) transceiver (figure 3 element 85 and column 8 lines 59-66) operably coupled to the RS232 cable (see column 6 lines 2-18, column 8 lines 24-35 and column 11 lines 18-26, wherein the personal scanner receives data information (price list) from the IR transceiver 85 as he/she enters the store and coupled to the computer store via port 40 (RS232) to check out), wherein at least one of the circuitry and the IR transceiver is actively coupled to the computer via the RS232 cable (As explained above, the personal scanner receives price list from the store via infrared port 85. Once he/she is done shopping, the

personal scanner is connected to the store's register (store's computer) via port 40 (RS232) to check out . . ."

The Examiner further states that "Rupert does not expressly teach USB cable and USB hub for data communication but Rupert further added any communication interface could be selected for communication. . . It would have been obvious to utilize USB for Rupert's system to increase communication performance because the USB provides data transfer rate is faster than RS232."

Applicants respectfully disagree with the Examiner. Rupert does not teach or suggest, either alone or in combination with other art, all of the elements of Applicants' invention as claimed in independent claims 1 and 7. In particular, Rupert does not teach or suggest a peripheral device, but instead teaches a standalone computer. Further, Rupert teaches away from the limitation of an infrared transceiver actively coupled to a cable, whether the cable is USB or otherwise, as explained below. Because Rupert does not teach or suggest a computer peripheral device comprising a USB/IR (infrared) transceiver operably coupled to a USB cable as claimed by Applicants in independent claims 1 and 7, claims 1-2, 4-8 and 10 (claims 2 and 4-6 depend from claim 1; claims 8 and 10 depend from claim 7) cannot be rendered obvious by Rupert, either alone or in combination with any other art.

In this regard, Applicants respectfully point out that in order to combine references for an obviousness rejection, there must be some teaching, suggestion or incentives supporting the combination. In re Laskowski,

871 F.2d 115, 117, 10 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989). The mere fact that the prior art could be modified does not make that modification obvious unless the prior art suggests the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, it is well established that Applicant's disclosure cannot be used to reconstruct Applicant's invention from individual pieces found in separate, isolated references. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

The Examiner states that Rupert teaches a computer peripheral device. Applicants respectfully disagree. Rupert in fact teaches a standalone computer that can interface with other computers for the retrieval of information, but not as a peripheral device for that computer. For example, even the title of Rupert states "Personal Scanner/Computer for Displaying Shopping Lists and Scanning Barcodes to Aid Shoppers". Further, Rupert states that "there is disclosed a personal bar code scanning device which comprises a microprocessor and associated control software coupled to a bar code reader, a display, and a bidirectional communication port/device, ROM or EPROM memory and random access memory." Column 1, lines 38-65. "In some embodiments, the Personal Scanner TM device will be implemented in the form of a palmtop computer." *Id.* These statements all teach towards a standalone computing device.

Further, at column 4, lines 34-39, Rupert states "The Personal Scanner TM device comprises, in the simplest embodiments, of a bar code reader coupled to a **specially**

programmed digital computer which can use the output of the bar code reader to identify the items placed in the basket and compare them to the currently selected shopping list." (Emphasis added). At column 3, lines 15-25, Rupert also states that the user can use an internal or external modem with the Personal Scanner device to dial a computer containing listing information. Further, at column 6, lines 5-18, Rupert teaches the downloading of information from an external computer (i.e., the store computer) to the Personal Scanner TM device. Nowhere does Rupert teach or suggest that the Personal Scanner device it discloses is a peripheral device to another computer. If anything, the examples from Rupert provided above teach or suggest that the external computers connected to for downloading of price information are peripheral to the disclosed invention. See also, column 8, lines 47-66.

Not only does Rupert teach away from a peripheral computer device as claimed by Applicants, but Rupert also does not teach or suggest the limitation of an infrared transceiver operably coupled to a cable, USB or otherwise. The Examiner cites column 6, lines 2-18, column 8, lines 24-35 and column 11, lines 18-26 in support of Examiner's claim that Rupert does teach this limitation. Applicants respectfully disagree. The cited text in fact teaches away from an infrared transceiver coupled to a cable, as it states, at column 6, lines 15-17, that the disclosed scanner "downloads the store's current price list using the infrared transceiver or the RS232 port." (Emphasis added). In other words, the infrared transceiver is independent of the RS232 (cable) connection. Further, at column 8, lines 64-66, Rupert teaches that the processing performed by the

disclosed invention is "the process of logging onto the store's local area network in infrared wireless fashion when the user enters the store and downloading the store's price list." Nowhere does Rupert teach or suggest the limitation of an infrared transceiver operably coupled to a cable for communication to an external computer, as claimed by Applicants in independent claims 1 and 7.

Applicants therefore respectfully submit that Rupert does not disclose Applicants' invention as claimed, either alone or in combination with the art of which the Examiner takes official notice (i.e., the use of a USB cable instead of an RS232 cable). Therefore, the rejection on a combination of these references is inappropriate. Applicants therefore respectfully request withdrawal of the rejection and allowance of independent claims 1 and 7.

Dependent claims 2 and 4-6 depend from independent claim 1 and contain, by virtue of their dependency, all of the limitations of the allowable independent claim from which they depend. Dependent claims 8 and 10 depend from independent claim 7 and contain, by virtue of their dependency, all of the limitations of the allowable independent claim from which they depend. Applicants therefore submit that dependent claims 2, 4-6, 8 and 10 are also patentably distinct and overcome the Examiner's rejection. Applicants therefore request that the Examiner remove the rejection and allow claims 2, 4-6, 8 and 10.

Claim Objections

The Examiner objected to claims 3 and 9 as being dependent upon a rejected base claim. For the reasons given above, Applicants believe all independent claims of the present application (claims 1 and 7) to be in condition for allowance. Thus, because claim 3 depends from allowable independent claim 1, claim 3 is patentably distinct and allowable as a further limitation upon claim 1. Similarly, because claim 9 depends from allowable independent claim 7, claim 9 is patentably distinct and allowable as a further limitation upon claim 7. Therefore, Applicants respectfully request the Examiner withdraw the objection and allow claims 3 and 9.

CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request full allowance of Claims 1-10.

An extension of one (1) month is requested and a Notification of Extension of Time Under 37 C.F.R. § 1.136 with the appropriate fee is attached hereto.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

Respectfully submitted,

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